

REMARKS

Claims 87-93 were pending. The Office has withdrawn claim 93 as being directed to a non-elected invention. Claim 88 has been cancelled. Accordingly, claims 87, 89-92 are pending.

The first paragraph of the specification has been amended to update the status of priority document USSN 08/219,200 in compliance with the Office's comments. No new matter has been added.

Claims 87, 89-91 have been amended according to the Office's suggestions in the Office Action dated December 1, 2003 as discussed below. No new matter has been added.

Support for amended claims 87 and 90 may be found in the specification at page 6, lines 33-35; page 7, line 11, and page 21, lines 21-26.

Support for amended claim 91 may be found in the specification at page 6, lines 33-35; page 7, line 11; pages 11-12; and page 21, lines 21-26.

Accordingly, Applicants request entry of the amendments to the claims and the specification.

Item 1 of the Office Action

The Office acknowledges that Applicants are in compliance with the Sequence Rules.

Item 2 of the Office Action

Applicants are pleased that the amendment dated September 30, 2002 has been entered. Applicants note that the amendment to which the Office refers was timely filed on September 23, 2002 rather than September 30, 2002.

Applicants note that the Office has withdrawn claim 93 from consideration as being directed to a non-elected invention.

Item 3 of the Office Action

Applicants are pleased that the Office has taken the position that priority application U.S. Serial No. 07/498,949, filed March 26, 1990, provides written support for the currently pending claims.

Item 4 of the Office Action

The Office states that drawings provided by Applicants comply with 37 CFR §1.84.

Item 5 of the Office Action

Applicants have amended the first paragraph of the specification to update the status of priority document USSN 08/219,200 in compliance with the Office's comments.

Item 6 of the Office Action

The Office merely quotes 35 U.S.C. §112, first paragraph and no response is due.

Item 7 of the Office Action

The Office rejects claim 88 under 35 U.S.C. §112, first paragraph, as not supported by the written description of the application.

Applicants respectfully disagree for the reasons of record.

However, to further prosecution of the application, Applicants herein cancel claim 88.

Item 8 of the Office Action

The Office has omitted a section entitled Item 8 in the Office Action dated December 1, 2003.

Item 9 of the Office Action

Applicants are pleased that the Office withdrew its previous rejection of claim 87 under 35 U.S.C. §112, first paragraph, in view of Applicants' amendments to the claims which now recited "B7 antigen having SEQ ID NO: 8".

Item 10 of the Office Action

Claims 87-92 are rejected under 35 U.S.C. §112, first paragraph.

The Office has taken the position that the claims are enabled for B7 antigen having SEQ ID NO: 8 or a B7 fusion protein having SEQ ID NO: 8. Further, the specification enables the phrase "a fragment of SEQ ID NO: 8" or "a fragment thereof" so long as these phrases are followed by "which binds CD28."

Applicants respectfully disagree for the need to add in the claims "which binds CD28" after the term "fragment thereof" to support enablement.

However, in order to further prosecution of the subject application, Applicants have amended independent claims 87 and 90 according to the Office's suggestions by reciting "fragment thereof which binds CD28."

The Office states that dependent claim 91 is required to recite SEQ ID NO:8 or the ATCC accession number for B7Ig. Applicants are unclear regarding the necessity for this requirement since claim 91 is dependent upon claim 90 which specifies use of B7 fusion protein having SEQ ID NO. 8. However, to further prosecution of the application, Applicants have amended claim 91 to insert SEQ ID NO:8.

The Office invites the Applicants to provide further guidance and direction to produce antibodies to B7 antigen. Applicants respectfully draw the Office's attention to (1) the specification as originally filed at pages 19-20 which provides a detailed description of methods to generate antibodies using an immunogen and (2) amended claims 87 and 90 now directed to use of immunogens such as B7 antigen or fusion protein having SEQ ID NO: 8, or fragments thereof which bind CD28.

In summary, claims 87, 90 and 91 have been amended according to the Office's suggestions. Claims 89, 91 and 92 are dependent upon independent claim 87 or 90 that have been amended according to the Office's suggestions. No new matter is added. Accordingly claims 87, 89-92 should be now in condition for allowance under 35 U.S.C. §112, first paragraph.

Item 11 of the Office Action

The Office rejects claims 87-92 as indefinite under 35 U.S.C. §112, second paragraph because the methods do not clearly set forth method steps and there is an absence of a resolution step which reads back on the preamble of the claimed methods. Further, claim 88 lacks a proper antecedent basis for the word “antibodies”.

Applicants disagree that the claims are indefinite.

However, to further prosecution of the application, Applicants have amended independent claims 87 and 90 by (1) replacing “using” with “immunizing” and (2) reiterating a passage from the preamble of each claim to their respective claim body. No new matter has been added. Accordingly, these claims should be in condition for allowance.

The rejection to claim 88 as lacking a proper antecedent basis for the word “antibodies” is now moot since claim 88 was cancelled.

Claims 89, 91 and 92 are dependent upon amended claims 87 and 90. Accordingly, claims 87, 89-92 should be now in condition for allowance under 35 U.S.C. §112, second paragraph.

Item 12 of the Office Action

The Office states that the rejection of claims under 35 U.S.C. §103(a) in the previous Office Action dated April 22, 2002 has been obviated by the subject application’s priority to USSN 07/498,949 filed March 26, 1990.

Applicants are pleased to note that the pending claims are free of prior art.

Item 13 of the Office Action

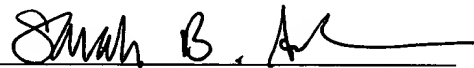
Item 13 states that Applicants may contact Examiner Gambel or Examiner's supervisor, Dr. J. Chan, regarding any inquiries related to prosecution of the subject application.

CONCLUSION

Applicants submit that the foregoing amendments put this application in condition for allowance, notice of which is respectfully requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

No fee, other than the \$110.00 extension fee, is due in connection with this Communication. However, if a fee is deemed necessary, Applicants hereby authorize the Patent Office to charge the fee to the Deposit Account No. 50-0306.

Respectfully submitted,



Sarah B. Adriano
Registration No. 34,470
Teresa Liang
Registration No. 51,946
Mandel & Adriano
55 S. Lake Avenue, Suite 710
Pasadena, California 91101
(626) 395-7801
Customer Number: 26,941